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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/769,828	02/02/2004	Jesse D. Crum	WK/2004-06/US	9079

7590 09/18/2006
WARD KRAFT, INC.
P.O. BOX 938
FORT SCOTT, KS 66701

EXAMINER

BATTULA, PRADEEP CHOUDARY

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 09/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/769,828

Applicant(s)

CRUM, JESSE D.

Examiner

Pradeep C. Battula

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 18 - 21 is/are rejected.
- 7) ☒ Claim(s) 16-17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/04/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: In Paragraph 0012, Line 4 the word "tk" should be replaced with "to". Appropriate correction is required.

Claim Objections

Claim 1 is objected to because of the following informalities: in Paragraph 3, Line 2 the words "first sheet" should be replaced with "second sheet". Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 9, and 10 – 12, 14, 15, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Campbell et al. (Campbell, U.S. 5,464,254).

In regards to Claim 1, Campbell discloses a business form intermediate suitable for carriage or portage of documents for processing, comprising; a laminate 10, said laminate having a first sheet 11 having a front face 13 and a back face 17 (Column 3, Line 56), said first sheet having first and second

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transversely extending end edges (not numbered) and first and second longitudinally extending side edges (not numbered) (Column 3, Lines 30 – 36; Figure 1, Items 11, 13) and said first sheet having a release surface (not numbered) on at least a portion of said second face (Column 4, Lines 30 – 33); said laminate including a second sheet 12 having a front face 19 and a back face 23 (Column 4, Lines 9 – 16), said first sheet having first and second transversely extending end edges and first and second longitudinally extending side edges (Figure 1) and said first face having a coating of adhesive 24 applied at least a portion of said first face (Column 4, Lines 9 – 16); and wherein said first sheet is juxtaposed in substantial alignment with said second sheet such that said release surface is disposed over said coating of adhesive to create a peelable portion of said laminate (Column 4, Lines 30 – 33; Figures, 1, 2).

In regards to Claim 9, as applied to Claim 1, Campbell discloses said first sheet is provided with at least one fold line 34 (Column 5, Lines 25 – 32; Figure 1, Item 34).

In regards to Claim 10, as applied to Claim 1, Campbell discloses said first sheet is provided with first 34 and second fold lines 36 (Column 5, Lines 25 – 32; Figure 1, Item 34, 36).

In regards to Claim 11, Campbell discloses a combination business form carrier 10 and business form 30, comprising; a business form carrier, said carrier including a laminate 10 produced from first 11 and second sheets 12 substantially juxtaposed on one another (Figure 1), said first and second sheets are held in resealable position through use of a release surface (not numbered;

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Column 4, Lines 30 – 33) and an adhesive coating 24 and each of said first and second sheets having an area (Column 3, Lines 30 – 36; Column 4, Lines 9 – 16); a business form 30 having a size less than each of the area of said first and second sheets of said business form carrier (Figure 2, Item 30), said business form having first and second faces and said business form is connected to a portion of said laminate on one of said first and second faces through said adhesive (Column 4, Lines 45 – 51; Figure 2) and wherein said business form carrier with said business form contained substantially entirely within said area of one of said first and second sheets of said laminate is attached to said carrier (Figure 2).

Furthermore, with respect to the carrier being processed through at least one of sorting, printing, reading, scanning equipment is rejected based product by process. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

In regards to Claim 12, and said release surface of Claim 11 being created through machine finishing at least one of said first and second sheets, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a

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product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

In regards to Claim 14, as applied to Claim 11, Campbell further discloses said business form is selected from a group including checks, coupons, tickets, passes, certificates and combinations thereof (Column 4, Lines 45 – 47).

In regards to Claim 15, Campbell discloses a method of using a business form carrier 10, comprising the steps of; providing a peelable laminate 10, said laminate including first 11 and second 12 sheets substantially juxtaposed on one another and at least partially adhered to one another through a release surface and adhesive coating 24 (Column 3, Lines 30 – 36; Column 4, Lines 9 – 16; Figure 1, Items 10, 11, 12, 24); revealing a portion of said laminate so as to expose an area of said adhesive coating by peeling back one of said first and second sheets such that said sheets are no longer in complete adhesive engagement with one another (Figure 1, Item 12). The document that is to be held in the carrier can be read, considering it is a license, therefore providing the form for scanning, sorting, printing, reading, handling or processing is inherent. Campbell further discloses affixing said business form to said portion of said laminate so that said business form is substantially entirely contained on said portion (Column 4, Lines 45 – 51; Figure 2, Items 12, 30). With respect to feeding said business form on said laminate through at least one of a scanning,

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sorting, printing, reading, handling or processing equipment is also inherent because the form has readable indicia that is not secure along with secure indicia and therefore can be scanned to check for security purposes (Column 5, Lines 35 – 42).

In regards to Claim 19, as applied to Claim 15, Campbell further discloses said business form 30 is selected from a group including checks, coupons, tickets, passes, certificates and combinations thereof (Column 4, Lines 45 – 47).

In regards to Claim 20, as applied to Claim 15, Campbell further discloses said business form 30 is provided with machine readable indicia 31 (Column 4, Lines 45 – 54).

In regards to Claim 21, as applied to Claim 20, Campbell disclose the claimed invention except for the specific arrangement and/or content of indicia (printed matter) set forth in the claim(s). It has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of pattern does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability.

The examiner asserts that the license comprising state specific indicia is the same structure claimed by applicant and the sole difference is in the content of the printed material. Thus, there is no novel and unobvious functional

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relationship between the printed matter (patterns) and the substrate (license) which is required for patentability.

Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter.

Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 3 – 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over (Campbell, U.S. 5,464,254) in view of Morgan (U.S. 3,854,229).

In regards to Claim 3, as applied to Claim 1, Campbell does not disclose said release surface is a release coating that is applied over an entire area of said first sheet.

Morgan discloses a laminated article with similar structure wherein said release surface is a release coating 18 that is applied over an entire area of said first sheet 16. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made use the release coating of

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Morgan in place of Campbell's release paper in order to prevent permanent adhesion and allow reuse of Campbell's invention.

In regards to Claim 4, as applied to Claim 3, Campbell modified by Morgan further discloses said release coating 18 is selected from a group including silicone, varnish, wax, gloss coatings and combinations thereof (Column 2, Lines 42 – 46 – of Morgan).

In regards to Claim 5, Campbell modified by Morgan discloses that the release coating covers an entire area of the first sheet therefore it is inherent that the release coating has an infinite amount of areas.

3. Claims 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over (Campbell, U.S. 5,464,254) and Morgan (U.S. 3,854,229) as applied to Claim 5, and in further view of Ou-Yang (U.S. 6,361,844).

In regards to Claim 6, Campbell modified by Morgan does not disclose the first area of release liner has greater release properties than the second area.

Ou-Yang teaches of two release liners 51 and 55 in two different areas where the first release liner 51 has a higher release property than release liner 55 (Column 8, Lines 28 – 54). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have two separate release liners of differing release properties in order to create an area of greater adhesion to where the cover cannot be accidentally lifted and have the adhesive exposed to unwanted objects and materials.

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4. Claims 2, 8, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over (Campbell, U.S. 5,464,254) in view of Greig et al. (Greig, U.S. 5,090,943).

In regards to Claim 2, Campbell discloses a business form intermediate as recited in Claim 1, wherein one of said first and second transversely extending end edges of said first sheet 11 extends beyond one of said first and second transversely extending end edges of said second sheet 12 (Column 3, Lines 49 – 55) creating a graspable tab at an end 21 (Figure 3, Items 11, 12, 21).

Campbell does not disclose that the tab enables separation of the peelable portion since the mounting point of sheet 12 is toward end 21.

Greig discloses a business form intermediate 10 which has a transparent cover 20 that is mounted at the top of the form (Column 3, Lines 28 – 33; Figure 1, Item 20). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to mount Campbell's second sheet twelve at upper end 20 in order to have the sheet 12 roll back or folded away from the carrier sheet 11 in order for easy insertion of any documents (Column 3, Lines 28 – 33 of Greig).

In regards to Claim 8, Campbell does not disclose said adhesive coating is a low tack adhesive.

Greig discloses a business form intermediate 10 as recited in claim 1, wherein said adhesive coating 14 is a low tack adhesive (Column 2, Lines 64 – 68). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use Greig's low tack adhesive in

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place of Campbell's adhesive in order to create an assembly where the liner is releasably secured and can be done so many times so that the invention can be used multiple times to hold different documents.

In regards to Claim 13, as applied to Claim 11, Campbell discloses a business form intermediate wherein one of said first and second transversely extending end edges of said first sheet 11 extends beyond one of said first and second transversely extending end edges of said second sheet 12 (Column 3, Lines 49 – 55) creating a graspable tab at an end 21 (Figure 3, Items 11, 12, 21).

Campbell does not disclose that the tab enables separation of the peelable portion since the mounting point of sheet 12 is toward end 21.

Greig discloses a business form intermediate 10 which has a transparent cover 20 that is mounted at the top of the form (Column 3, Lines 28 – 33; Figure 1, Item 20). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to mount Campbell's second sheet twelve at upper end 20 in order to have the sheet 12 roll back or folded away from the carrier sheet 11 in order for easy insertion of any documents (Column 3, Lines 28 – 33 of Greig).

5. Claims 7 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over (Campbell, U.S. 5,464,254) in view of Newing et al. (Newing, U.S. 5,318,815).

In regards to Claim 7, as applied to Claim 1, Campbell does not disclose that the release surface is provided through machine finished paper.

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Newing teaches of a release surface that is created by machine finishing a sheet (Column 2, Lines 44 – 50). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use a machine finished sheet with a release surface in order to have a solid release surface that will substantially remain with the sheet to which it is finished on (Column 4, Lines 18 – 20).

In regards to Claim 18, as applied to Claim 15, Campbell does not disclose that the release surface is created by machine finishing either the first or second sheet.

Newing teaches of a release surface that is created by machine finishing a sheet (Column 2, Lines 44 – 50). Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use a machine finished sheet with a release surface in order to have a solid release surface that will substantially remain with the sheet to which it is finished on (Column 4, Lines 18 – 20).

Allowable Subject Matter

6. Claims 16 – 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pradeep C. Battula whose telephone number is 571-272-2142. The examiner can normally be reached on Monday - Friday 7:00AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PCB
Patent Examiner
September 11, 2006


MONICA CARTER
SUPERVISORY PATENT EXAMINER